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| ARENT FOX LLP | | | HU, KANG | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com

IPMatters@arentfox.com

Patent_Mail@arentfox.com

Office Action Summary

Application No.

10/772,449

Applicant(s)

BOON, JOHN F.

Examiner

KANG HU

Art Unit

3715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/18/2008 has been entered. Claims 15 and 16 has been cancelled, claims 1-14, and 17-20 are currently pending in the application.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10, 17, 19 and 20 are rejected under USC 101, the claimed invention is directed to non-statutory subject matter. In order to be considered patent eligible under 35 USC 101, a claimed process must contain a sufficient tie to a machine, article of manufacture or a composition of matter. In re Comiskey, 84 USPQ2d 1670 (Fed. Cir. 2007). In this case, the claimed invention does not have a sufficient tie to any machine, article of manufacture or a composition of matter. The claimed method could be nothing more than a software program, claims to computer software program per se are not statutory subject matter. Claims 2-9, 19 and 20 are also rejected for their dependency upon claims 1, and 17.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-14, and 17-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7,011,526 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Re claim 1, the application recites “a method for providing an authoring tool for enhancing long-term memory, the memory comprising: providing a graphical user interface input for receiving content; receiving the content, the received content including at least one query input and associated response; and formatting the content for user with a query and response feature; wherein the query and response feature includes: providing each of the at least one query, each of the at least one query having an associated memory retention value which is a specific number measured on a scale; receiving a response to each of the at least one query; evaluating the

response to each of the at least one query; updating the associated memory retention value for each of the at least one query based on the response to the evaluated response; scheduling a review of the at least one query based on the associated memory retention value; and prior to the scheduled review of the at least one query, placing that at least one query in a passive display status, wherein the passive display status includes intermittently passively displaying the at least one query and an associated correct response.

Claim 1 of '526 recites 1. A method for enhancing long-term memory, comprising: providing a query, the query having an associated memory retention value; receiving a response to the query; determining whether the response to the query is correct; updating the associated memory retention value for the query based on the response to the query; and displaying the query and the correct response to the query in a quick display mode once the memory retention value for the query reaches a predetermined value.

It would have been obvious to one of ordinary skill in the art at the time of invention to realize that the contents of claims 1-16 of '526 describes essentially the same concept and steps for performing the method for providing an authoring tool.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Schaack et al. (US 6,652,283 B1).

Re claim 1: Van Schaack discloses a method for providing an authoring tool for enhancing long-term memory, the method comprising: providing a graphical user interface input (Figs 1-52) for receiving content; receiving the content, the received content including at least one query input and associated response; and formatting the content for use with a query and response feature; wherein the query and response feature includes: providing each of the at least one query, each of the at least one query having an associated memory retention value which is a specific number measured on a scale; Van Schaack has number of score values associated with memory retention, one for example is shown in Fig 24, where the scores are rated from 1-5. Van Schaack teaches the specific number measure on a scale of memory retention value in col 43, specifically lines 10-20; receiving a response to each of the at least one query; evaluating the response to each of the at least one query; and updating the associated memory retention value (figs 2-6) for each of the at least one query based on the response to the evaluated response (Figs 1-53; col 1-10). Van Schaack further teaches of scheduling review of the at least one query based on the associated memory retention value, (Abstract: review and testing modules arrange to operate interactively, review and test modules are changed based on a user's past performance). Van Schaack does not explicitly teach of prior to the scheduled review of the at least one query, placing the at least one query in a passive display status, wherein the passive display status includes intermittently passively displaying the at least on query and an associated correct response. Van Schaack

discloses of the student may review the group of known items in the same manner, the learning and review is performed by a student simply looking at flashcards to determine correct responses and reviewing cards as desired (col 1, lines 45-55). It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize passively reviewing the query with the associated answer as memorization is formed with practice, as the student also accomplishes learning the material, a brief overview of the material will reinforce the memory of the student.

Van Schaack further teaches:

Re claim 2: The method of claim 1, wherein each of the at least one query comprises a representation of a flash card interpreted as a form of paired-associate learning (col 5-7).

Re claim 3: The method of claim 1, wherein the at least one query comprises input selected from a group consisting of a graphical prompt, a text prompt, an audio prompt, and a video prompt (col 7, lines 1-17).

Re claim 4: The method of claim 1 wherein the at least one query comprises a plurality of linked prompts (col 7, lines 1-17).

Re claim 5: The method of claim 1, further comprising: displaying a correct response to each of the at least one query (col 4, lines 1-67; col 5 and 6).

Re claim 6: The method of claim 5, wherein the correct response is displayed for a variable time period (fig 13a).

Re claim 7: The method of claim 6, wherein the variable time period dynamically adjusts depending on number of incorrect answers to each of the at least one query received (col 4, lines 40-67; col 7, lines 45-67; col 37 and 38).

Re claim 8: The method of claim 1, further comprising: repeating the providing of each of the at least one query at variable intervals, the intervals varying with response time taken for at least one previously received response (col 37 and 38).

Re claim 9: The method of claim 2, wherein providing at least one query includes: presenting a display of a representation of a query flash card, the query flash card including a query; and presenting a display of a plurality of selectable responses to the query via a plurality of representations of answer flash cards (figs 40-44).

Re claim 10 invokes 35 U.S.C. 112 sixth paragraph and will be treated as such. The means for providing a graphical user interface, receiving the content, formatting the content for user with query and response feature, providing each of at least one query, each of the query having an associated memory retention value, receiving a response to each query, evaluating the response to the query and updating the associated memory retention value for each query based on response to the evaluated response have been discussed in claims 1-9 above.

Re claims 11-16: the device as claimed has been discussed in claims 1-9, further claim of the device comprising of terminal selected from group of persona computer, minicomputer, a microcomputer, a main frame computer and a slot machine; the display coupled to a display processor and the user of internet (col 8, lines 40-51).

Re claim 17: A method for providing a multimedia output via an authoring tool, the method comprising: receiving a plurality of multimedia data feeds; providing at least one option for combining the multimedia data feeds; receiving at least one selection for combining the multimedia data feeds; formatting the combined multimedia data feeds; and producing the multimedia output from the combined multimedia data feeds (col 9, and 13 -15). Additional limitation discussed in claim 1 above and not repeated herein.

Re claim 18: The method of claim 17, wherein the multimedia output is a compact disk containing data (col 15, lines 18-25).

Re claim 19: The method of claim 17, wherein the plurality of multimedia data feeds includes a voice over stream interpreted as any audio stream (col 9, lines 29-41; col 13, lines 6-24).

Re claim 20: The method of claim 17, wherein the plurality of multimedia data feeds includes at least one video stream (col 9, lines 29-41; col 13, lines 6-24).

Response to Arguments

7. Applicant's arguments with respect to claims 1, 10, 11 and 17 with regard to the newly amended limitations have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KANG HU whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-262-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kang Hu/
Examiner, Art Unit 3715

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/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715